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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,683	05/22/2001	Perry Biancavilla	10005929-1	1273

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT PAPER NUMBER

3628

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,683

Applicant(s)

BIANCAVILLA, PERRY

Examiner

Siegfried E. Chencinski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/22/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being disclosed by Kalin (Walmart Struggles to Get Up to Speed http://webbusiness.cio.com/archive/12400_walmart_content.html).

Re. Claim 1, Kalin discloses a method for distributing purchased goods at retail or wholesale outlet stores, comprising the steps of:

- providing a mechanism for customers to remotely order the goods stored at the one or more retail and/or wholesale outlet stores and receive order confirmation information (page 1, ll. 1-9, 24-36);
- wherein the one or more agreements provide that, upon presentation of the order confirmation information at a retail and/or wholesale outlet store associated with the order confirmation information, possession of goods associated with the order confirmation information is transferred to a presenter of the order confirmation information (p. 2, ll. 11-13, in-store pick-up recommendation).

Kalin does not explicitly disclose entering into one or more agreements with one or more retail and/or wholesale outlet stores to store and distribute goods that are different from displayed goods at the retail and/or wholesale outlet stores. However, Kalin discloses that 600,000 products were for sale on the Walmart web site in January 2000 versus the 100,000 products found in a typical Walmart Supercenter. This arrangement suggests the claimed concept of one or more retail and/or wholesale outlet stores to store and distribute goods that are different from displayed goods at the retail and/or wholesale outlet stores. Further, it is well known that the products carried by retail

stores and wholesale outlet stores are largely based on agreements with manufacturers or master distributors. Also, it has been well known that many if not most stores have traditionally taken orders for products they do not stock. With online shopping and order placement and instant electronic network communications between retailers and distributors and manufacturers, such orders are quickly communicated to a manufacturer or to a distribution center belonging to the retailer or to a manufacturer so that the product is quickly delivered to the store or to the customer and, in case of in-store pickup, the customer is told when they can pick up the product or have it delivered, as chosen by the customer.

It would have been obvious to an ordinary practitioner at the time of Applicant's invention to have modified Kalin's disclosure with well known retailing practices to offer a method for distributing purchased goods at retail or wholesale outlet stores, motivated by the opportunity to use brick-and-mortar presence to full online advantage (Kalin, p. 2, ll. 10-11).

Re. Claim 2, Kalin does not explicitly disclose a method for distributing purchased goods at retail or wholesale outlet stores wherein at least one of the agreements provides one or more of the retail and/or wholesale outlet stores an exclusive territory with respect to distribution of the goods. However, it is well known that many manufacturers give exclusive geographic territories to retail or outlet stores as a mutually beneficial incentive for the retailer to promote the manufacturer's particular product line and to carry inventory of a mutually agreed items of the product line. This is a judgment made by each manufacturer as part of their distribution strategy for maximizing sales on each product category they are manufacturing. Therefore, it would have been obvious to the ordinary practitioner to combine the Kalin disclosure with well known distribution practices in order to provide a method for distributing purchased goods at retail or wholesale outlet stores wherein at least one of the agreements provides one or more of the retail and/or wholesale outlet stores an exclusive territory with respect to distribution of the goods, motivated by the opportunity to use brick-and-mortar presence to full online advantage (Kalin, p. 2, ll. 10-11).

Re. Claim 3, Kalin does not explicitly disclose a method for distributing purchased goods at retail or wholesale outlet stores wherein the step of entering into one or more agreements is preceded by the step of soliciting competing bids from prospective retail or wholesale outlet stores to provide storage and distribution services. However, it is a well known practice to solicit competing bids from prospective retail or wholesale outlet stores to provide storage and distribution services because a manufacturer normally contacts numerous retailers and/or outlet store operators in the geographic areas of interest to him to solicit bids or terms and conditions from such store operators before deciding on which store operators to enter into agreements with. Therefore, it would have been obvious to the ordinary practitioner to combine the Kalin disclosure with well known practices wherein the step of entering into one or more agreements is preceded by the step of soliciting competing bids from prospective retail or wholesale outlet stores to provide storage and distribution services, motivated by the opportunity to use brick-and-mortar presence to full online advantage (Kalin, p. 2, ll. 10-11).

Re. Claim 4, Kalin discloses a method for distributing purchased goods at retail or wholesale outlet stores wherein the mechanism for customers to remotely order the goods comprises a Website (page 1, ll. 1-9, 24-36).

Re. Claim 5, Kalin does not explicitly disclose a method for distributing purchased goods at retail or wholesale outlet stores wherein the one or more agreements additionally require the retail or wholesale outlet stores to package goods associated with the order confirmation information after the order confirmation information is presented to the retail or wholesale outlet stores. However, instore packaging of products has been well known in retailing. For example, premium coffee beans have been stored in bulk and packaged at the time of customer delivery, with or without on the spot grinding. Fruit and produce have likewise stored and dispensed in the same way. Food stores began to offer remote online and telephone orders for groceries in the 1980's, pioneered by companies such as Peapod. Brick and mortar supermarkets joined in the 1990's. IN hardware products, many products still are distributed in bulk and stored in bins, barrels, sacks, etc. Examples are the large variety of fasteners known as nails and screws, and also hinges, batteries, small light bulbs, etc. It would

have been obvious to the ordinary practitioner at the time of Applicant's invention to combine Kalin's disclosures with the requirement for retailers to package goods associated with the order confirmation information after the order confirmation information is presented to the retail or wholesale outlet stores, motivated by the opportunity to use brick-and-mortar presence to full online advantage (Kalin, p. 2, ll. 10-11).

Re. Claim 6, Kalin suggests a method for distributing purchased goods at retail or wholesale outlet stores which comprises the step of electronically providing a retail or wholesale outlet store associated with the order confirmation information with a packing list associated with the order confirmation information after the order confirmation information is presented to the retail or wholesale outlet store (p. 1, ll. 24-36; p. 2, ll. 11-13. This facility is made obvious because electronic order confirmation and a packing list or receipt of some kind, perhaps printed online by or for the customer are suggested by Kalin by the disclosure of the ability to return items, which has been a very broad practice and by the recommendation in the Kalin disclosure for an in-store pick-up option of an online purchase.).

Re. Claim 7, Kalin suggests a method for distributing purchased goods at retail or wholesale outlet stores comprising the step of electronically transferring funds to a retail or wholesale outlet store associated with the order confirmation information after the order would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention because of the well known and virtually universal practice of retailers and distribution organizations transferring financial credit for sales to the location or outlet which actually transacts delivery of the merchandise. Financial responsibility accounting also suggests or requires such transfers because the cost of the goods shipped to and stored by the retail location must be accepted by the retail location except for cases of consignment, which is an exception and not a widespread practice. Whether this credit is given entirely to the delivery location or given in dual fashion to the online facility and the pick-up location is immaterial because the ordinary practitioner of the art at the time of Applicant's invention would have seen it as obvious

to transfer revenue funds to the store which accepts delivery of the product and which then will deliver the product to the customer.

Re. Claim 8, Kalin does not explicitly disclose a method for distributing purchased goods at retail or wholesale outlet stores wherein the one or more agreements additionally require the retail or wholesale outlet stores to receive the goods in bulk containers. However, it is well known that many products are received in bulk containers by stores. This is directly related to claim 6, because products which are packaged in a store at the time of final transfer to the customer are by definition received in bulk packaging. Bulk packaging for delivery to retailers is as well known as the related instore packaging of products. It would have been obvious to the ordinary practitioner at the time of Applicant's invention to combine Kalin's disclosures with the requirement for the retail or wholesale outlet stores to receive the goods in bulk containers for final packaging for instore delivery to the customer, motivated by the opportunity to use brick-and-mortar presence to full online advantage (Kalin, p. 2, ll. 10-11).

Re. Claim 9, Kalin does not explicitly disclose a method for distributing purchased goods at retail or wholesale outlet stores wherein the one or more agreements additionally require the retail or wholesale outlet stores to return the bulk containers once the bulk containers are empty. However, it is well known that many industries find it economical to require retailers to return bulk packaging to the manufacturer. Examples include pallets, trailers, railcars, tank cars and trailers used for transporting liquid products. This is primarily a matter of the economics involved in each case. When the total costs of returning bulk containers exceed the cost of using new bulk packaging for each bulk shipment, then returns of bulk containers are not requested or even welcomed by the shipper of bulk products. It would have been obvious to the ordinary practitioner of the art at the time of Applicant's invention combine Kalin's disclosures with the requirement for the retail or wholesale outlet stores to return the bulk containers once the bulk containers are empty return the bulk containers once the bulk containers are empty, motivated by the opportunity to use brick-and-mortar presence to full online advantage (Kalin, p. 2, ll. 10-11).

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Re. Claim 10, Kalin does not explicitly disclose a method for distributing purchased goods at retail or wholesale outlet stores wherein the one or more agreements additionally require the retail or wholesale outlet stores to distribute the goods in intimate level protection packaging. However, it is a widespread, and virtually universal practice in the United States to provide the "intimate" type of packaging as defined in Applicant's specification, which describes intimate packaging to be the routine packaging commonly provided by retailers, such as paper and plastic bags, with or without handles, as is the norm in American retailing. It would have been obvious to the ordinary practitioner of the art at the time of Applicant's invention to combine Kalin's disclosures with one or more agreements which require the retail or wholesale outlet stores to distribute the goods in intimate level protection packaging, motivated by the opportunity to use brick-and-mortar presence to full online advantage (Kalin, p. 2, ll. 10-11).

Re. Claim 11, Kalin discloses a method for distributing purchased goods at retail or wholesale outlet stores, comprising the steps of:

- receiving order pick-up information from a customer (p. 2, ll. 11-13);

Kalin does not explicitly disclose:

- electronically transferring the order pick-up information to a remote order processing facility and electronically receiving a packing list associated with the order pick-up information; and
- pulling goods identified in the packing list from bulk containers and providing the goods to the customer without distribution packaging.

However, electronic order placement for customer pick-up would have made it obvious to the ordinary practitioner at the time of the invention that the order pick-up information will be electronically transferred to a remote order processing facility with a packing list associated with the order pick-up information. Also obvious would have been the pulling of goods identified in the packing list from appropriate stock held at the pick-up location. As stated in the above rejections, transfer of goods from bulk containers into a variety of practical packaging which fits the customer's needs for taking the product home has been

well known in the US for a long time, which is why distribution packaging is not needed for such sales. It would have been obvious to the ordinary practitioner of the art at the time of Applicant's invention to combine Kalin's disclosures with features which are obvious in a method to provide goods to a customer without distribution packaging at a pick-up location after the customer's online order placement for pick-up by the customer, motivated by the opportunity to use brick-and-mortar presence to full online advantage (Kalin, p. 2, ll. 10-11).

Re. Claims 12-15, Kalin does not explicitly disclose a method for distributing purchased goods at retail or wholesale outlet stores comprising the step of:

Re. Claim 12, packaging the goods in intimate level protection packaging before providing the goods to the customer.

Re. Claim 13, the intimate level protection packaging includes one or more bags.

Re. Claim 14, packaging the goods in one or more structurally reinforced bags.

Re. Claim 15, method for distributing purchased goods at retail or wholesale outlet stores of claim 12, further comprising the step of packaging the goods in one or more bags with handles.

However, **Re. Claim 12-15**,

Re. Claim 12, as stated above in the rejection of claim 10, it is a widespread and virtually universal practice in the United States to provide the "intimate" type of protection packaging defined in Applicant's specification, which describes the routine packaging such as paper and plastic bags, without handles as is the norm in American retailing. It would therefore have been obvious to the ordinary practitioner of the art at the time of Applicant's invention to make use of this ubiquitous practice which is already in place throughout retail America since customers are used to it and because it would incur no incremental costs to make use of.

Re. Claim 13, one or more bags make up the packaging provided for the customer a large percentage of the time at retail stores across America.

Re. Claim 14, one or more structurally reinforced bags have been a well known and common type of packaging provided to customers by retail stores across America for purchases requiring such bags.

Re. Claim 15, bags with handles for packaging goods for the customer to take home have been a well known and common type of packaging provided to customers by retail stores across America for purchases requiring such bags or even only for the customer's preference or convenience.

Re. Claims 12-15, it would have been obvious to the ordinary practitioner of the art at the time of Applicant's invention to combine Kalin's disclosures with the well known practices of retail or wholesale outlet stores to distribute the goods in a variety of intimate level protection packaging, motivated by the opportunity to use brick-and-mortar presence to full online advantage (Kalin, p. 2, ll. 10-11).

Re. Claim 16, Kalin discloses a processing system for distributing purchased goods at retail or wholesale outlet stores, comprising computer systems hardware, software and electronic communications networks to manage it national and global business, including online ordering of goods and services (The entire Kalin article is devoted to disclosing information about Walmart.com and specifically Walmart's national online shopping facilities as the looked in January 2000. Specific information of interest is on p. 1, ll. 24-26, p. 2, ll. 11-13, 19-29; and p. 2, l. 43 – p. 3, l. 21).

- Including are a large array of processors making the Walmart.com system work (p. 2, l. 43 – p. 3, l. 21).

Kalin does not explicitly disclose a processor configured to receive an inventory verification request and information pertaining to a geographic location, to identify one or more retail or wholesale outlet stores that are within a particular distance of the geographic location and that have in stock goods identified in the inventory verification request, and to generate a list of the one or more retail or wholesale outlet stores.

However, it was well known at the time of Applicant's invention that many processors were in use in US retailing, programmed to receive an inventory verification request and information pertaining to a geographic location, to identify one or more retail or wholesale outlet stores that are within a particular distance of the geographic location and that have

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in stock goods identified in the inventory verification request, and to generate a list of the one or more retail or wholesale outlet stores. Therefore, it would have been obvious to the ordinary practitioner of the art at the time of Applicant's invention to use Kalin's disclosure and well known information to distribute purchased goods at retail or wholesale outlet stores by making use of processors configured to receive an inventory verification request and information pertaining to a geographic location, to identify one or more retail or wholesale outlet stores that are within a particular distance of the geographic location and that have in stock goods identified in the inventory verification request, and to generate a list of the one or more retail or wholesale outlet stores, motivated by the opportunity to use brick-and-mortar presence to full online advantage (Kalin, p. 2, ll. 10-11).

Re. Claims 17-21, Kalin does not explicitly disclose a system for distributing purchased goods at retail or wholesale outlet stores wherein:

Re. Claim 17, wherein the processor is further configured to generate order confirmation information associated with the goods identified in the inventory verification request and with one of the retail or wholesale outlet stores on the list.

Re. Claim 18, wherein the order confirmation information is associated with the retail or wholesale outlet store on the list that is closest to the geographic location.

Re. Claim 19, wherein the order confirmation information is associated with the retail or wholesale outlet store on the list that is selected by a purchaser of the goods.

Re. Claim 20, wherein the processor is further configured to provide a packing list associated with the goods identified in the inventory verification request in response to an indication that the order confirmation information has been provided to the retail or wholesale outlet store associated with the order confirmation information.

Re. Claim 21, wherein the processor is further configured to initiate a transfer of funds in response to an indication that the order confirmation information has

been provided to the retail or wholesale outlet store associated with the order confirmation information.

However,

Re. Claim 17, Kalin discloses the suggestion that Walmart use its brick-and-mortar system to its competitive advantage by giving the online customer the choice of picking up a Walmart online purchase at the store location of the customer's choice (p. 2, ll. 11-13). It would have been obvious to the ordinary practitioner at the time of applicant's invention to have one or more processors configured to generate order confirmation information associated with the goods identified in the inventory verification request and with one of the retail or wholesale outlet stores on the list because the customer would choose a store for personal pick-up of their purchased goods when the customer's circumstances make such pick-up their most convenient option.

Re. Claim 18, associating the order confirmation information with the retail or wholesale outlet store on the list that is closest to the geographic location would have been obvious to the ordinary practitioner with a geographically diverse system of retail stores because the customer would choose a store for personal pick-up of their purchased goods when the customer's circumstances make such pick-up their most convenient option.

Re. Claim 19, associating the order confirmation information with the retail or wholesale outlet store on the list that is selected by a purchaser of the goods location would have been obvious to the ordinary practitioner in the case of a geographically diverse system of retail stores because the customer would choose a store for personal pick-up of their purchased goods when the customer's circumstances make such pick-up their most convenient option.

Re. Claim 20, configuring the processor to provide a packing list associated with the goods identified in the inventory verification request in response to an indication that the order confirmation information has been provided to the retail or wholesale outlet store associated with the order confirmation information would have been obvious to the ordinary practitioner because this is how

thousands of retail computer systems are configured when a purchase transaction has been completed.

Re. Claim 21, configuring a processor to initiate a transfer of funds in response to an indication that the order confirmation information has been provided to the retail or wholesale outlet store associated with the order confirmation information would have been obvious to the ordinary practitioner because it is well known that this is standard accounting practice in retailing in order to maintain the integrity of the accounting system in the organization or even between organizations.

Re. Claims 17-21, it would have been obvious to the ordinary practitioner of the art at the time of Applicant's invention to combine Kalin's disclosures with the well known retail online sales, distribution, delivery and accounting practices of retail or wholesale outlet stores to distribute purchased goods at retail or wholesale outlet stores, motivated by the opportunity to use brick-and-mortar presence to full online advantage (Kalin, p. 2, ll. 10-11).

Conclusion

2. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Sough, can be reached on (571) 272-6799.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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Commissioner of Patents and Trademarks, Washington D.C. 20231
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(571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or
"DRAFT"]

Hand delivered responses should be brought to the address found on the above
USPTO web site in Alexandria, VA.

SEC

December 12, 2005


FRANTZY POINVIL
PRIMARY EXAMINER
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